

REMARKS:

Claims 1-35 are pending in the present Application.

Claim 27 has been amended to correct a minor typographical error. Claim 35 has been amended to improve the grammar thereof. These amendments to claims 27 and 35 are not necessitated by prior art and are unrelated to the patentability of the present invention.

Claims 11, 22, and 33 have been amended to more particularly point out and distinctly claim the invention.

Claims 1-4, 9, 11-15, 20, 22-26, 31, and 33-35 stand rejected under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2003/0037063 to Schwartz ("Schwartz"). Claims 5, 8, 10, 16, 19, 21, 27, 30, and 32 stand rejected under 35 U.S.C. § 103(a) over Schwartz. Claims 6, 7, 17, 18, 28, and 29 stand rejected under 35 U.S.C. § 103(a) over Schwartz in view of U.S. Patent Application Publication No. 2002/0059093 to Barton et al. ("Barton").

REJECTIONS UNDER 35 U.S.C. § 102:

Claims 1-4, 9, 11-15, 20, 22-26, 31, and 33-35 stand rejected under 35 U.S.C. § 102(e) over Schwartz. This rejection is respectfully traversed.

A claim is anticipated by a prior art reference only if the reference discloses or inherently describes every detail of the claim. According to the MPEP, "[a] claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."¹ Also according to the MPEP, "[T]he identical invention must be shown in as *complete detail* as is contained in the ... claim."²

¹ MPEP 2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added.

² MPEP 2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989), emphasis added.

Schwartz fails to disclose many of the limitations recited in the present claims. Several of these distinguishing limitations are discussed below. The discussion below is not intended to be exhaustive in terms of the ways in which the claims are patentably distinguishable over Schwartz. Applicants reserve the right to point out further ways in which the claims are patentable over Schwartz, should the need arise. Thus, omissions of ways in which the claims patentably distinguish over Schwartz are not to be treated as concessions.

Claims 1-4, 9, and 11

Claim 1 is directed towards a system for assessing risk associated with a software implementation project. Claim 1 includes several limitations limiting the scope of this claim to risk assessment associated with software implementation. For example, claim 1 recites “the importance value...reflecting...the extent to which the risk factor may negatively impact a *software implementation project*” and “receive an actual score for a particular *software implementation project* for each risk factor based on an analysis by the implementing entity specific to the particular *software implementation project*” among the many limitations specifically relating the claim to software implementation project risk assessment.

Schwartz, in contrast, has nothing to do with software implementation projects or assessment of risks associated therewith. Instead, Schwartz is directed towards risk assessment of people who are under supervision because they may be subject to some form of risk, such as mental health patients or parolees. Given that a claim cannot be anticipated unless “*each and every element* as set forth in the claim is found” in a single prior-art reference, since Schwartz fails to disclose any of the several recited elements in claim 1 related to software implementation projects, Schwartz cannot anticipate claim 1.

Claim 1 also recites multiplication of an importance value and a maximum score to define a *potential* weighted score. Not only does Schwartz fail to disclose multiplying an importance value and a maximum value as claimed, Schwartz is silent with respect to a *potential* weighted score.

Claims 2-4, 9, and 11 depend from claim 1. Thus, the discussion above in connection with claim 1 applies equally to claims 2-4, 9, and 11.

Claims 2-4, 9, and 11 are further considered patentable over Schwartz since these claims recite further limitations that are not disclosed by Schwartz. For example, Schwartz fails to disclose generating a scorecard for display that provides “the importance value, maximum score, potential weighted score, actual score, actual weighted score, and risk level for each risk factor in a spreadsheet format” as recited in claim 2. Schwartz is silent with respect to software implementations, so Schwartz fails to disclose that values or scores remain constant “across multiple software implementations” as recited in claim 3. Claim 3 also distinguished Schwartz because Schwartz fails to disclose that “the maximum score is the same for each risk factor.”

With respect to claim 9, since this claim depends from claim 8 and the Office Action essentially concedes that Schwartz fails to anticipate claim 8, it necessarily follows for at least this reason that Schwartz cannot anticipate claim 9.

Also note that claim 11 has been amended to clarify that “maximum score” refers to a “maximum *attainable* score.” This is in contrast to the “maximum acceptable value” disclosed in Schwartz, which is clearly not a maximum attainable value or score. Claims 22 and 33 have been similarly amended.

Claims 12-15, 20, 22-26, 31, and 33-35

Independent claims 12, 23, 34, and 35 recite limitations similar to those discussed above in connection with claim 1. Therefore, the discussion above in connection with claim 1 applies equally to claims 12, 23, 34, 35, and their dependent claims.

Also, the discussion above in connection with claim 2 applies equally to claims 13, 24, and 35; the discussion above in connection with claim 3 applies equally to claims 14, 25, and 35; the discussion above in connection with claim 9 applies equally to claims 20, 31, and 35; and the discussion above in connection with claim 11 applies equally to claims 22 and 33.

For the reasons set forth herein, the Applicants submit that claims 1-4, 9, 11-15, 20, 22-26, 31, and 33-35 are not anticipated by Schwartz. The Applicant further submits that claims 1-4, 9, 11-15, 20, 22-26, 31, and 33-35 are in condition for allowance. Therefore, the Applicant respectfully requests that the rejection of claims 1-4, 9, 11-15, 20, 22-26, 31, and 33-35 be reconsidered and that claims 1-4, 9, 11-15, 20, 22-26, 31, and 33-35 be allowed.

THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.
6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

REJECTIONS UNDER 35 U.S.C. § 103:

Claims 5, 8, 10, 16, 19, 21, 27, 30, and 32

Claims 5, 8, 10, 16, 19, 21, 27, 30, and 32 stand rejected under 35 U.S.C. § 103(a) over Schwartz.

Claims 5, 8, and 10 depend from independent claim 1, claims 16, 19, and 21 depend from independent claim 12, and claims 27, 30, and 32 depend from independent claim 23. Since each of claims 1, 12, and 23 is considered to be in condition for allowance as discussed above, claims 5, 8, 10, 16, 19, 21, 27, 30, and 32 are considered to be in condition for allowance by virtue of the fact that they depend from an allowable claim. In addition, claims 5, 8, 10, 16, 19, 21, 27, 30, and 32 set forth additional subject matter that is considered to be patentably distinguishable over Schwartz as discussed below.

The Examiner relies on a taking of Official Notice for limitations recited in claims 5, 8, 10, 16, 19, 21, 27, 30, and 32. Applicant hereby traverses the taking of Official Notice in connection with the limitations recited in claims 5, 8, 10, 16, 19, 21, 27, 30, and 32, because the asserted facts are not supported by documentary evidence and appear to be the Examiner's opinions formulated using the present application as a template, which constitutes impermissible use of hindsight.

"Official Notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While 'official notice' may be relied upon, these circumstances should be rare when an application is under final rejection or action under 37 C.F.R. 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be 'capable of such instant and unquestionable demonstration as to defy the dispute'(citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." MPEP § 2144.03(A) (emphasis in original).

"It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03(A) (emphasis in original).

The Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of "instant and unquestionable" demonstration as being well-known. Thus, if the Examiner continues to maintain the rejection of claims 5, 8, 10, 16, 19, 21, 27, 30, and 32 based on the Official Notice, the Applicant requests that the Examiner provide documentary evidence as stated in Section 2144.03 of the M.P.E.P. Further, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. (See MPEP § 2144.03(C)).

For the reasons set forth herein, the Applicant submits that claims 5, 8, 10, 16, 19, 21, 27, 30, and 32 are not rendered obvious by Schwartz. The Applicant further submits that claims 5, 8, 10, 16, 19, 21, 27, 30, and 32 are in condition for allowance. Therefore, the Applicant respectfully requests that the rejection of claims 5, 8, 10, 16, 19, 21, 27, 30, and 32 be reconsidered and that claims 5, 8, 10, 16, 19, 21, 27, 30, and 32 be allowed.

Claims 6, 7, 17, 18, 28, and 29

Claims 6, 7, 17, 18, 28, and 29 stand rejected under 35 U.S.C. § 103(a) over Schwartz in view of Barton.

Claims 6 and 7 depend from independent claim 1, claims 17 and 18 depend from independent claim 12, and claims 28 and 29 depend from independent claim 23. Since each of claims 1, 12, and 23 is considered to be in condition for allowance as discussed above, claims 6, 7, 17, 18, 28, and 29 are considered to be in condition for allowance by virtue of the fact that they depend from an allowable claim. In addition, claims 6, 7, 17, 18, 28, and 29 set forth additional subject matter that is considered to be patentably

distinguishable over the proposed combination of Schwartz and Barton as discussed below.

For example, with respect to claims 6, 17, and 28, the proposed combination of Schwartz and Barton fails to disclose or suggest a risk factor category scorecard providing category percentage risk for each risk factor category. The Office Action relies specifically on Figure 17 of Barton for alleging prior teaching of this particular limitation; however, a review of Barton, Figure 17 revealed no such teaching.

With respect to claims 7, 18, and 29, the proposed combination of Schwartz and Barton fails to disclose or suggest generating a spider chart for display having rays extending from a vertex reflective of category percentage risks and data points on the rays reflective of percentage risks. The Office Action relies specifically on Figure 16 of Barton for alleging prior teaching of this particular limitation; however, a review of Barton, Figure 16 revealed no such teaching. The Office Action also relies on a taking of Official Notice for limitations recited in claims 7, 18, and 29. Applicant hereby traverses the taking of Official Notice in connection with the limitations recited in claims 7, 18, and 29, because the asserted facts are not supported by documentary evidence and appear to be the Examiner's opinions formulated using the present application as a template, which constitutes impermissible use of hindsight. The Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of "instant and unquestionable" demonstration as being well-known. Thus, if the Examiner continues to maintain the rejection of claims 7, 18, and 29 based on the Official Notice, the Applicant requests that the Examiner provide documentary evidence as stated in Section 2144.03 of the M.P.E.P. Further, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. (See MPEP § 2144.03(C)).

For the reasons set forth herein, the Applicant respectfully submits that claims 6, 7, 17, 18, 28, and 29 are not rendered obvious by the proposed combination of Schwartz and Barton. The Applicant further submits that claims 6, 7, 17, 18, 28, and 29 are in condition

for allowance. Therefore, the Applicant respectfully requests claims 6, 7, 17, 18, 28, and 29 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's

disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:


In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing the Amendment to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

3/29/06
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